



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/023,150

12/17/2001

Naoyuki Matsumoto

CANO:041

3168

7590

11/17/2006

ROSSI & ASSOCIATES

P.O. Box 826

Ashburn, VA 20146-0826

EXAMINER

SCHLACK, SCOTT A

ART UNIT

PAPER NUMBER

2625

DATE MAILED: 11/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/023,150

Applicant(s)

MATSUMOTO, NAOYUKI

Examiner

Scott A. Schlack

Art Unit

2625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 August 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 December 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Applicant's amendment was received on 08/25/2006, and has been entered and made of record. Currently, claims **1-32** are pending.

Response to Amendment

2. The examiner notes that the applicant has amended all independent claims **1, 11, 21, 31** and **32**, as well as dependent claims **2-8, 10, 12-18, 20** and **22-30**.

3. The examiner withdraws the 35 U.S.C. 101 rejections pertaining to claims **21-30** in response to the applicant's amendment.

Response to Arguments

4. Applicant's arguments with respect to the newly amended features in independent claims **1, 11, 21, 31** and **32** have been considered but are not persuasive. The examiner references the applicant to the new claims rejection section below.

5. With respect to claims **1, 11, 21, 31** and **32**, the applicant amends the claims to contain the added features of the document delivery apparatus comprising: (a) receiving means for receiving document information of a document generated from any of the external devices, and (b) wherein the delivery destination includes at least on of the servers or an external device that processes the delivered document.

The applicant then argues that, "Eldridge's token-aware document delivery server 138 does not receive any document information of a document generated from any external device (e.g., file server 104, printer 102, scanner 110, etc.). Rather, Eldridge's delivery server 138 merely delivers the formatted document to

Art Unit: 2625

a driver or interface for accessing one of the document processing devices (i.e., printer 102 or personal workstation 108). Eldridge simply has no corresponding delivery setting function that provides delivery setting based on the received document information and delivering the received document to the determined delivery setting."

Examiner's Response: In response to the applicant's assertion that "Eldridge's token-aware document delivery server 138 does not receive any document information of a document generated from any external device (e.g., file server 104, printer 102, scanner 110, etc.)", the examiner notes that Eldridge's Token Enabled Server (126 of Fig 1) is said to include tokenaware services shown figuratively as a dotted rectangle encompassing various individual servers (col 4, lines 39-47). The examiner therefore views all functionality attributed to each encompassed server device to capably reside on a (one) Token Enabled Server Device. This interpretation is fully supported by Eldridge's invention (col 4, lines 39-47). As such, the examiner notes that Eldridge's Token Enabled Server captures a document from a scanner (110 of Fig 1) or a similar input device (col 5, lines 41-45). The examiner views this as being equivalent to receiving document information of a document generated from any of the external devices. Further, in the document request from an external device, the Token Enabled Server receives a token, representing a document information, from a client device.

In response to the applicant's assertion that, "Eldridge simply has no corresponding delivery setting function that provides delivery setting based on

Art Unit: 2625

the received document information and delivering the received document to the determined delivery setting.", the examiner notes that upon receipt of a token (request from a client device), the Token Enabled Server (126 of Fig 1), retrieves and sends the document to a viewing device via its driver or interface (col 5, lines 33-38 and col 6, lines 5-21). The examiner views this document delivery, facilitated by the Token Enabled Server, to be equivalent to a delivery setting function that provides delivery setting based on the received document information (token) delivering the received document to the determined delivery setting (document viewing device.).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims **1-3, 6-13, 16-23** and **26-32** are rejected under 35 U.S.C. 103(a) as being unpatentable over Eldridge et al. (US 6,397,261).

8. With respect to claim **1**, Eldridge et al. discloses a document delivery apparatus (Token Enabled Server 126 comprising Document Delivery Server 138 of Fig 1) connected via a network (Intranet 116 and Internet 122 of Fig 1) to a plurality of external devices (102,110, 104, 112, 106,107, 118 and 126 of Fig 1) and a plurality of servers (104, 112,106, 107 and 126 of Fig 1), comprising:
receiving means for receiving document information (token) of a document

Art Unit: 2625

generated from any of the external devices (scanner 110 of Fig 1: col 5, lines 41-45); delivery setting means for making delivery settings (col 5, lines 34-46 and 442 of Fig 8) for the document based on the document information received by the receiving means; and delivery means for determining a delivery destination of the document, based on the delivery settings (col 5, lines 34-46 and 422 of Fig 8), and for delivering the document to the determined delivery destination (442 of Fig 8) and wherein the delivery destination includes an external device that processes the delivered document (Mobile Devices 118 of Fig 1).

The examiner notes that the Token Enabled Server (126 of Fig 1) is said to include tokenaware services shown figuratively as a dotted rectangle encompassing various individual servers (col 4, lines 39-47). The examiner therefore interprets all functionality attributed to each encompassed server device to reside on a (one) Token Enabled Server. This interpretation is fully supported by Eldridge's invention (col 4, lines 39-47). The examiner notes that the Token Enabled Server receives a token representing document information from a requesting device (col 4, line 61 through col 5, line 4). The stored document being requested is said to have been originally captured from a scanner (110 of Fig 1) or a similar acquisition device (col 5, lines 41-45). The examiner views this as being equivalent receiving document information of a document generated from any of the external devices.

The examiner interprets a delivery setting means for making delivery settings as being necessarily inherent to the process of delivering the document, via an appropriate printer driver, to a selected document processing device (col

Art Unit: 2625

5, lines 34-46). The examiner further notes that in selecting the appropriate printer driver for a given document-processing device, the delivery servers (128 and 138 of Fig 1) make and utilize delivery settings. Also, the examiner notes that the in receiving the document from the Token Enabled Server, the requesting device (Mobile Device issuing the token) inherently processes the delivered document (i.e., storing it or viewing it).

Eldridge et al. does not disclose wherein the delivery destination includes at least one of the servers.

The examiner notes that Eldridge et al. does disclose a plurality of servers (Fig 1), and that it would have been obvious at the time of the invention for one skilled in the art to take Eldridge's Destination Device and combine it with his plurality of Server Devices, such that the Destination Device was said to include at least on of the servers.

The suggestion or motivation for doing so would have been to explicitly state that the delivery destination could be one of the servers.

9. Claim **11** recites identical features as claim 1 except claim 11 is a method claim. Thus, arguments similar to that presented above for claim 1 are also equally applicable to claim 11.

10. Claim **21** recites identical features as claim 1 except claim 21 is a computer-readable medium claim. Thus, arguments similar to that presented above for claim 1 are also equally applicable to claim 21. The examiner further, notes that it is necessarily inherent that the Document Delivery Servers (128 and 138 of Fig 1) comprise some type of memory or computer-readable medium to function.

Art Unit: 2625

11. Claim **31** recites identical features as claim 1 except claim 31 is a computer-readable medium claim. Thus, arguments similar to that presented above for claim 1 are also equally applicable to claim 31. The examiner further notes that it is necessarily inherent that the Document Delivery Servers (128 and 138 of Fig 1) comprise some type of memory or computer-readable medium to function.

12. With respect to claim **32** the examiner notes identical features to claim 1. Therefore, the explanation given above for claim 1 is also valid for claim 32.

13. With respect to claim **2**, Eldridge et al. discloses a document delivery apparatus according to claim 1, wherein the servers include (col 5, lines 34-45 and 442 of Fig 8) a document management server that manages documents (Network File Server 104 of Fig 1) and a mail server that delivers electronic mails (Network Email Server 112 of Fig 1).

14. Claim **12** recites identical features as claim 2 except claim 12 is a method claim. Thus, arguments similar to that presented above for claim 2 are also equally applicable to claim 12.

15. Claim **22** recites identical features as claim 2 except claim 22 is a computer-readable medium claim. Thus, arguments similar to that presented above for claim 2 are also equally applicable to claim 22. The examiner further notes that it is necessarily inherent that the Document Delivery Servers (128 and 138 of Fig 1) comprise some type of memory or computer-readable medium to function.

16. With respect to claim **3**, Eldridge et al. discloses a document delivery apparatus according to claim 1, wherein the at least one server comprises a document management server that manages documents (104 Network File

Art Unit: 2625

Server 104 and Shared Document Server 134 of Fig 1), and said delivery means comprises control means for delivering additional information acquired from the external device together with the document information to said document management server as index information, and registering the document information and the index information in said document management server (col 5, lines 34-46).

The examiner notes that the Document Delivery Servers (128 and 138 of Fig 1) store documents to the Network File Server or the Shared Document Server (104 and 134 of Fig 1) from external devices such as a fax machine or a scanner (col 5, lines 41-45). The examiner further notes that in order to retrieve one of these documents utilizing token information, the document stored in the document management servers need to have reference token information. The examiner interprets this additional reference information to be equivalent to index information, which is registered on the Document Delivery Servers in order to facilitate extraction of documents via tokens (col 7, lines 41-58).

17. Claim **13** recites identical features as claim 3 except claim 13 is a method claim. Thus, arguments similar to that presented above for claim 3 are also equally applicable to claim 13.

18. Claim **23** recites identical features as claim 3 except claim 23 is a computer-readable medium claim. Thus, arguments similar to that presented above for claim 3 are also equally applicable to claim 23. The examiner further notes that it is necessarily inherent that the Document Delivery Servers (128 and 138 of Fig 1) comprise some type of memory or computer-readable medium to function.

Art Unit: 2625

19. With respect to claim 6, Eldridge et al. discloses a document delivery apparatus according to claim 1, wherein the delivery settings are set (418 and 442 of Fig 8) for each of the plurality of external devices (118 of Fig 1) that is a transmission sources of the document information (col 5, lines 34-45).

The examiner interprets the document information as being equivalent to the document tokens, which are sent from the mobile computing devices (118 of Fig 1) and further notes that it is necessarily inherent that the document delivery apparatus (Token Enabled Servers 126 comprising Document Delivery Server 138 of Fig 1), which receives these tokens, set the corresponding delivery settings.

20. Claim 16 recites identical features as claim 6 except claim 16 is a method claim. Thus, arguments similar to that presented above for claim 6 are also equally applicable to claim 16.

21. Claim 26 recites identical features as claim 6 except claim 26 is a computer-readable medium claim. Thus, arguments similar to that presented above for claim 6 are also equally applicable to claim 26. The examiner further notes that it is necessarily inherent that the Document Delivery Servers (128 and 138 of Fig 1) comprise some type of memory or computer-readable medium to function.

22. With respect to claim 7, Eldridge et al. discloses a document delivery apparatus according to claim 1, further comprising control means for controlling said delivery setting means such that delivery settings are made in accordance with instructions from any of said external devices (118 of Fig 1 and col 5, lines 34-45).

Art Unit: 2625

The examiner notes that it is necessarily inherent that the Document Delivery Servers (128 and 138 of Fig 1) control delivery setting means, such that delivery settings are made in accordance with instructions (tokens) from any of said external devices (118 of Fig 1 and col 5, lines 34-45).

23. Claim 17 recites identical features as claim 7 except claim 17 is a method claim. Thus, arguments similar to that presented above for claim 7 are also equally applicable to claim 17.

24. Claim 27 recites identical features as claim 7 except claim 27 is a computer-readable medium claim. Thus, arguments similar to that presented above for claim 7 are also equally applicable to claim 27. The examiner further notes that it is necessarily inherent that the Document Delivery Servers (128 and 138 of Fig 1) comprise some type of memory or computer-readable medium to function.\

25. With respect to claim 8, Eldridge et al. discloses a document delivery apparatus according to claim 1, wherein the document information comprises received fax document (Network Fax Server 106 of Fig 1) information or scan document (Scanner 110 of Fig 1) information (col 5, lines 41-45).

26. Claim 18 recites identical features as claim 8 except claim 18 is a method claim. Thus, arguments similar to that presented above for claim 8 are also equally applicable to claim 18.

27. Claim 28 recites identical features as claim 8 except claim 28 is a computer-readable medium claim. Thus, arguments similar to that presented above for claim 8 are also equally applicable to claim 28. The examiner further notes that it

Art Unit: 2625

is necessarily inherent that the Document Delivery Servers (128 and 138 of Fig 1) comprise some type of memory or computer-readable medium to function.

28. With respect to claim 9, Eldridge et al. discloses a document delivery apparatus according to claim 1, wherein, when the document information is in a format different from one handled by the delivery destination, said delivery means converts the format of the document information to the one handled by the delivery destination (440 of Fig 8 and col 12, lines 53-62) and then delivers the document information to the delivery destination (442 of Fig 8 and col 12, lines 62-67).

29. Claim 19 recites identical features as claim 9 except claim 19 is a method claim. Thus, arguments similar to that presented above for claim 9 are also equally applicable to claim 19.

30. Claim 29 recites identical features as claim 9 except claim 29 is a computer-readable medium claim. Thus, arguments similar to that presented above for claim 9 are also equally applicable to claim 29. The examiner further notes that it is necessarily inherent that the Document Delivery Servers (128 and 138 of Fig 1) comprise some type of memory or computer-readable medium to function.

31. With respect to claim 10, Eldridge et al. discloses a document delivery apparatus according to claim 1, wherein the external devices (102, 110, 104, 112, 106, 107, 118 and 126 of Fig 1) each have at least one function of an image reading function (Scanner 110 of Fig 1), a facsimile transmission, or a reception function (Network Fax Server 106 of Fig 1).

Art Unit: 2625

The examiner interprets the Scanner (110 of Fig 1) to inherently have an image reading function.

32. Claim **20** recites identical features as claim 10 except claim 20 is a method claim. Thus, arguments similar to that presented above for claim 10 are also equally applicable to claim 20.

33. Claim **30** recites identical features as claim 10 except claim 30 is a computer-readable medium claim. Thus, arguments similar to that presented above for claim 10 are also equally applicable to claim 30. The examiner further notes that it is necessarily inherent that the Document Delivery Servers (128 and 138 of Fig 1) comprise some type of memory or computer-readable medium to function.

34. Claims **4**, **14** and **24** are rejected under 35 U.S.C. 103(a) as being unpatentable over Eldridge et al. (US 6,397,261) in view of Wells et al. (US 5,999,601).

35. With respect to claim **4**, Eldridge et al. discloses a document delivery apparatus according to claim 3, wherein the received document information comprises a fax document information received by fax (fax server 106 of Fig 1 and col 5, lines 41-45).

The examiner notes that the Document Delivery Servers (126 and 138 of Fig 1) store documents to the Network File Server or the Shared Document Server (104 and 134 of Fig 1) from external devices such as a fax server or a scanner (col 5, lines 41-45)

Eldridge et al. does not disclose wherein the additional information comprises at least one of information on a transmitter of the received fax

Art Unit: 2625

document, reception time information relating to the received fax document, or document page number information.

Wells et al. does disclose stored facsimile information comprising reception time information relating to the received fax document (col 4, lines 65-67 and col 5, lines 1-4).

Eldridge et al. and Wells et al. are analogous art, because they are from the same field of endeavor, namely Image Data Communications.

At the time of the invention, it would have been obvious for one skilled in the art to combine Eldridge et al's document delivery apparatus according to claim 3, wherein the received document information comprises a fax document information received by fax, with Wells et al's stored facsimile information comprising reception time information relating to the received fax document such that the additional information disclosed in claim 3 comprises the reception time information.

The suggestion or motivation for doing so would have been to explicitly state that reception time information is included in the additional information.

36. Claim **14** recites identical features as claim 4 except claim 14 is a method claim. Thus, arguments similar to that presented above for claim 4 are also equally applicable to claim 14.

37. Claim **24** recites identical features as claim 4 except claim 24 is a computer-readable medium claim. Thus, arguments similar to that presented above for claim 4 are also equally applicable to claim 24. The examiner further notes that it

Art Unit: 2625

is necessarily inherent that the Document Delivery Servers (128 and 138 of Fig 1) comprise some type of memory or computer-readable medium to function.

38. Claims **5**, **15** and **25** are rejected under 35 U.S.C. 103(a) as being unpatentable over Eldridge et al. (US 6,397,261) in view of Adamske et al. (US 6,615,234).

39. With respect to claim **5**, Eldridge et al. discloses a document delivery apparatus according to claim 1, wherein the at least one server comprises a document management server (104 Network File Server 104 and Shared Document Server 134 of Fig 1) that manages documents, and wherein the document delivery apparatus (Token Enabled Servers 126 comprising Document Delivery Server 138 of Fig 1 and col 5, lines 41-45) further comprises control means.

Eldridge et al. does not disclose wherein the document delivery apparatus comprises control means operable when the received document information is delivered to the document management server, for notifying by electronic mail to at least one predetermined electronic mail address that the document information has been registered.

Adamske et al. does disclose notifying by electronic mail to at least one predetermined electronic mail address that the document information has been delivered (col 4, lines 30-39).

Eldridge et al. and Adamske et al. are analogous art, because they are from the same field of endeavor, namely Document Delivery.

Art Unit: 2625

At the time of the invention, it would have been obvious for one skilled in the art to combine Eldridge et al's document delivery apparatus according to claim 1, wherein the delivery destination for the received document information comprises a document management server, with Adamske et al's notifying by electronic mail to at least one predetermined electronic mail address that the document information has been delivered.

The suggestion or motivation for doing so would have been to explicitly state that an email notification is sent out to at least one predetermined electronic mail address that the document information has been registered.

40. Claim **15** recites identical features as claim 5 except claim 15 is a method claim. Thus, arguments similar to that presented above for claim 5 are also equally applicable to claim 15.

41. Claim **25** recites identical features as claim 5 except claim 25 is a computer-readable medium claim. Thus, arguments similar to that presented above for claim 5 are also equally applicable to claim 25. The examiner further notes that it is necessarily inherent that the Document Delivery Servers (128 and 138 of Fig 1) comprise some type of memory or computer-readable medium to function.

Conclusion

42. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

Art Unit: 2625


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Scott A. Schlack whose telephone number is (571)272-7954. The examiner can normally be reached on 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kimberly A. Williams can be reached on (571)272-7471. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2625

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Scott A. Schlack

KIMBERLY WILLIAMS
SUPERVISORY PATENT EXAMINER